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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,052	11/23/1999	SEISHI SUEHIRA	1075.1124/JD	3304
21171	7590	04/27/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			NGUYEN, CHAU T	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/447,052

Applicant(s)

SUEHIRA, SEISHI

Examiner

Chau Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Amendment, received on 02/22/2005, has been entered. Claims 1-63 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-63** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,377,956 B1 to Hsu et al., issued April 23, 2002, filed February 22, 1999 in view World Wide Web Consortium, *XML Schema Part I: Structures*, W3C Working Draft (May 6, 1999). With respect to the rejection of each dependent claim below, the preceding rejection(s) of the relevant base claim(s) is incorporated therein.

Regarding **independent claims 1, 49, 56 and 63**, Hsu et al. teach setting in advance an original document storage file-system directory for storing the non-structured documents inasmuch as they teach specifying database tables or external

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files for the storage of component documents. (Hsu et al., col. 3, lines 20-44 and col. 7, lines 26-32: the component document retriever for storing the component documents in various subdirectories of a machine-specific directory) Hsu et al. also teach setting in advance a structured document file-system directory area for storing structured documents obtained by conversion of the non-structured documents. (Hsu et al., col. 8, lines 16-18: "In the media preparation process, all source documents are processed and converted into standard formats, in particular, SGML, and are stored in the document database.")

Further, Hsu et al. do not explicitly teach but it would have been obvious to one of ordinary skill in the art to store the non-structured document into the original storage file-system directory each time it was prepared or edited because it would have been obvious to one of ordinary skill that it would be desirable to have the most updated version of the non-structured document available for conversion to a structured document. (Hsu et al., col. 8, lines 16-18, quoted above.)

Further, Hsu et al. teach converting the non-structured documents into structured documents and storing them in the structured document storage file-system directory. (Hsu et al., col. 3, lines 20-44 and col. 8, lines 16-18.)

Further, Hsu et al. disclose a configuration process that assembles a set of related product documents may be automated more efficiently and effectively (col. 7, line 33 – col. 8, line 25). However, Hsu et al. do not teach acquiring document names of the structured documents and preparing corresponding entity declarations referring to the structured documents. However, *XML Schema Part 1* teaches in section 3.6.2 on

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page 38 external parsed entities, “a feature of XML that offers a method for including well-formed XML document fragments, including text and markup, by direct reference to the storage object of the parsed entity.” Further, in the example at the top of page 39, *XML Schema Part I* depicts entity declarations containing the names of structured documents. One of ordinary skill in the art would have recognized that these entity declarations provide a straightforward and efficient way to refer to component documents, and therefore, it would have been obvious to one of ordinary skill in the art to extend Hsu et al. to acquire document names of the structured documents and prepare entity declarations for referring to entities of the structured documents.

Further, Hsu et al. disclose do not teach adding entity the declarations to the hub document responsive to the presence of the structured documents in the structured document file-system directory. However, *XML Schema Part I* in the example in section 3.6.2 on page 39 depicts a hub document based on the entity declarations regarding the structured documents. Moreover, one of ordinary skill in the art would have recognized that basing a hub document on the entity declarations would have provided the benefit of flexible and efficient document production, allowing reuse of components in different documents and ensuring that the most up-to-date versions of components were used. Therefore, it would have been obvious to one of ordinary skill in the art to prepare the hub document based on the entity declarations regarding the structured documents.

Regarding **dependent claims 2, 50 and 57**, Hsu et al. teach an attachment file storage area set in advance, and storing attachment files into the storage directory, inasmuch as they teach the original file storage directory as discussed above regarding

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claim 1 and further state that “[m]edia files, which are also document objects, are also managed in the same way as component documents.” (Hsu et al., col. 3, lines 20-44 and col. 7, lines 25-26.) Further, Hsu et al. do not teach preparing entity declarations for the attachment file or preparing the hub document based on the entity declarations for the attachment files as well as the entity declarations for the structured documents, but these elements would have been obvious to one of ordinary skill in the art in view of *XML Schema Part 1* under the same rationale stated above regarding claim 1 for the obviousness of creating entity declarations and preparing the hub document based on the entity declarations regarding the structured documents.

Regarding **dependent claims 3, 51 and 58**, the rejection of claim 2 above is fully incorporated herein. Further, Hsu et al. do not teach setting in advance an entity declaration storage directory. However, in view of the obviousness of using entity declarations, discussed above regarding claim 1, it further would have been obvious to one of ordinary skill in the art to have set in advance an entity storage area because one of ordinary skill would have recognized the benefit of having a central storage area from which entity declarations could be accessed and used for multiple documents.

Regarding **dependent claims 4-6, 52 and 59**, Hsu et al. do not teach the entity declarations of the structured documents having file names corresponding to the file names of the original unstructured document. However, one of ordinary skill in the art would have recognized that giving entity declarations the same names as the original unstructured document would have had the benefit of making clear to what original

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document the entity declaration referred, and therefore the step recited in these claims would have been obvious to one of ordinary skill in the art.

Regarding **dependent claims 7-12, 53 and 60**, Hsu et al. do not teach the entity declarations for the attachment files having file names corresponding to the file names of the non-structured documents to which the attachment files are attached. However, one of ordinary skill in the art would have recognized that giving attachment entity declarations the same names as the original unstructured document would have had the benefit of making clear to what original document the attachment was attached, and therefore the step recited in these claims would have been obvious to one of ordinary skill in the art.

Regarding **dependent claims 13-24, 54 and 61**, Hsu et al. teach the attachment files being graphic files including graphic information. (Hsu et al., col. 7, lines 61-65: "For each component document, the author also prepares for all needed multimedia files for diagrams, images, drawings, etc. in some standard formats such as CGM, TIFF, GIF, etc., which may be incorporated in the SGML files.")

Regarding **dependent claims 25-48, 55 and 62**, Hsu et al. teach that the structured documents a Standard Generalized Markup Language (SGML) documents whose structure is defined by a Document Type Definition (DTD). (Hsu et al., col. 7, lines 33-37: "Component documents are preferably represented in SGML (See SGML: Standard Generalized Markup Language, ISO/IEC 8879:1986). SGML is a meta-language for defining document structures, referred to as Document Type Definition (DTD). An SGML document structure is an instance of its associated DTD.")

Response to Arguments

In the remarks, Applicant argued in substance that

A) Proposed modification of Hsu would change the principle of operation.

B) No motive to make proposed modification when problem solved thereby does not exist in reference.

As to point B, In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, In this case, Hsu et al. teach setting in advance an original document storage file-system directory for storing the non-structured documents inasmuch as they teach specifying database tables or external files for the storage of component documents. (Hsu et al., col. 3, lines 20-44 and col. 7, lines 26-32: the component document retriever for storing the component documents in various subdirectories of a machine-specific directory) Hsu et al. also teach setting in advance a structured document file-system directory area for storing structured documents obtained by conversion of the non-

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structured documents. (Hsu et al., col. 8, lines 16-18: "In the media preparation process, all source documents are processed and converted into standard formats, in particular, SGML, and are stored in the document database." Further, Hsu et al. do not explicitly teach but it would have been obvious to one of ordinary skill in the art to store the non-structured document into the original storage file-system directory each time it was prepared or edited because it would have been obvious to one of ordinary skill that it would be desirable to have the most updated version of the non-structured document available for conversion to a structured document. (Hsu et al., col. 8, lines 16-18, quoted above.)

C) Prima facie case of obviousness not made; Failure to consider portions of Hsu that lead away from including entity/reference responsive to presence in directory. The Examiner proposes modifying Hsu to include "adding entity declarations to the hub document responsive to the presence of the structured document in the structured document file-system directory".

As to point C, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the Examiner did not modify Hsu to include "adding entity declarations to the hub document responsive to the presence of the structured document in the structured document file-system directory". Instead, the

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Examiner's used another reference to reject the above limitation. In this case, Hsu et al. disclose do not teach adding entity the declarations to the hub document responsive to the presence of the structured documents in the structured document file-system directory. However, *XML Schema Part 1* in the example in section 3.6.2 on page 39 depicts a hub document based on the entity declarations regarding the structured documents. Moreover, one of ordinary skill in the art would have recognized that basing a hub document on the entity declarations would have provided the benefit of flexible and efficient document production, allowing reuse of components in different documents and ensuring that the most up-to-date versions of components were used. Therefore, it would have been obvious to one of ordinary skill in the art to prepare the hub document based on the entity declarations regarding the structured documents.

D) Rejection improper; Limitation found in body of claim, not preamble.

As to point D, in response to applicant's arguments, the recitation "entity references" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Suppose entity declarations are read as “entity references” or “document references”, then in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Hsu et al. disclose do not teach adding entity declarations to the hub document responsive to the presence of the structured documents in the structured document file-system directory. However, *XML Schema Part I* in the example in section 3.6.2 on page 39 depicts a hub document based on the entity declarations regarding the structured documents. Moreover, one of ordinary skill in the art would have recognized that basing a hub document on the entity declarations would have provided the benefit of flexible and efficient document production, allowing reuse of components in different documents and ensuring that the most up-to-date versions of components were used. Therefore, it would have been obvious to one of ordinary skill in the art to prepare the hub document based on the entity declarations regarding the structured documents.

E) Improper reliance on personal knowledge of examiner/official notice

As to point E, the Examiner now provides the reference Sato et al. (Sato), US Patent No. 6,014,680, to support the official notice on page 4 in the previous rejection. Examiner wrote “Hsu et al. do not explicitly teach but it would have been obvious to one

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of ordinary skill in the art to store the non-structured document into the original storage file-system directory each time it was prepared or edited because it would have been obvious to one of ordinary skill that it would be desirable to have the most updated version of the non-structured document available for conversion to a structured document. (Hsu et al., col. 8, lines 16-18, quoted above.). Sato teaches converting a non-structured document into a structured document (col. 1, lines 61-67). Sato also teaches storing generated structured document in the structured document repository (col. 6, line 66 – col. 7, line 35 and Fig. 18).

F) Rejection fails to address all limitations of the claims such as “acquiring document names of the structured documents and preparing corresponding entity declarations referring to the structured documents”.

As to point F, Hsu et al. disclose do not teach adding entity the declarations to the hub document responsive to the presence of the structured documents in the structured document file-system directory. However, *XML Schema Part I* in the example in section 3.6.2 on page 39 depicts a hub document based on the entity declarations regarding the structured documents. Moreover, one of ordinary skill in the art would have recognized that basing a hub document on the entity declarations would have provided the benefit of flexible and efficient document production, allowing reuse of components in different documents and ensuring that the most up-to-date versions of components were used.

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Therefore, it would have been obvious to one of ordinary skill in the art to prepare the hub document based on the entity declarations regarding the structured documents.

G) Advantage over prior art

As to point G, even though Hsu stated “collecting all documents and engineering data for a new product may take an extended period of time” (col. 16, lines 2-4), however, claim 1 does not suggest, imply or even disclose “a hub document can be prepared in short time with little effort” as cited on page 20 of the remarks. Therefore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., collecting all documents and engineering data for a new product may take an extended period of time) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

H) Prior art does not respond to presence of documents in a directory.

As to point H, Hsu teaches storing documents in various subdirectories of a machine-specific directory (col. 3, lines 20-44, col. 4, line 52 – col. 5, line 4).

I) Rejection fails to address claims as a whole.

4. As to point I, In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Also, "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Hsu et al. disclose do not teach adding entity the declarations to the hub document responsive to the presence of the structured documents in the structured document file-system directory. However, *XML Schema Part I* in the example in section 3.6.2 on page 39 depicts a hub document based on the entity declarations regarding the structured documents. Moreover, one of ordinary skill in the art would have recognized that basing a hub document on the entity declarations would have provided the benefit of flexible

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and efficient document production, allowing reuse of components in different documents and ensuring that the most up-to-date versions of components were used. Therefore, it would have been obvious to one of ordinary skill in the art to prepare the hub document based on the entity declarations regarding the structured documents.

J) Rejection inconsistent

As to point J, Hsu et al., col. 3, lines 20-44 and col. 7, lines 26-32: the component document retriever for storing the component documents in various subdirectories of a machine-specific directory (file-system directory).

5. Applicant's arguments filed 02/22/2005 have been fully considered but they are not persuasive. Please see the rejection and response to arguments above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (703) 305-4639. The Examiner's future phone number is (571) 272-4092, which will be effective sometime in October 2004. The Examiner can normally be reached on Monday-Friday from 8:00 am to 5:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Joseph Feild, can be reached at (703) 305-9792.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chau Nguyen
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JOSEPH FEILD
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